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| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER | | | | |
| DWIVEDI, MAHESH H | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2168 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/664,189

Applicant(s)

THORPE, JONATHAN RICHARD

Examiner

MAHESH H. DWIVEDI

Art Unit

2168

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 7/21/09
13. ☐ Other: _____.

/Tim T. Vo/
Supervisory Patent Examiner, Art Unit 2168

/Mahesh H Dwivedi/
Examiner, Art Unit 2168

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's request for reconsideration filed on 09/11/2009 is acknowledged, but is not persuasive. Applicants argue on page 02 that "it is respectfully noted that Claim 21 is a method claim having two steps: "storing" and "transmitting," contrary to the assertion in the outstanding office action that "They are clearly not a series of steps."" However, the examiner was referring to "client system having logic" as not a series of steps. Logic does not represent instructions/steps, and thus is non-statutory subject matter. Applicants argue on page 02 that "it is respectfully submitted that the correct test for subject matter eligibility is the machine or transformation test described in *In re Bilski*. In the present case, Claim 21 recites a particular machine or apparatus, namely a storage node including an indexer and a client system. Consequently, it is respectfully submitted that Claim 21 (and Claim 23 dependent therefrom) is in compliance with all requirements under 35 U.S.C. 101". However, the examiner is rejecting Claim 21 for containing non-statutory subject matter of logic. Applicants argue on page 02 that "The outstanding Office Action again fails to even mention the opinion of *In re Bilski*, much less explain how the pending claims do not comply with that opinion. If the present rejection is to be maintained, it is respectfully requested that the next office communication identify how the pending claims are not in compliance with *In re Bilski* for the purpose of facilitating" the appeals process". However, once again the claims themselves contain non-statutory subject matter of "logic". Logic in and of itself is non-statutory, and thus the 101 rejection was proper. Although a particular machine is claimed, logic is still non-statutory by itself, and thus, Claims 21 and 23 are rejected under 101. Applicants argue on pages 3-4 that "it is respectfully submitted that the specific aims of Fanning are not aligned with those of the invention in Claim 1, in which smaller representations of larger information items held at a remote storage node are passed from the remote storage node to a claim if an index at the storage node indicates that this smaller representation has not yet been sent to the client. The client can then use this smaller representation to indicate a position of the respective information item within an array that is topologically arranged to indicate similar information items at similar positions". However, the examiner wishes to refer to Column 13 of Fanning which states "In an alternative embodiment shown in FIG. 9, the distribution application 1100 contains an audio file module 1102, which includes an audio file player 1106, as well as an audio file converter 1104. The audio file player 1106 plays files located in the data file repository 1116, while the audio file converter 1104 generates audio files either by sampling data from a microphone or tape, or by converting data stored on a CD-ROM or hard disk into a standard compressed audio file format. Converted audio files are placed in the repository 1116, allowing other users in the community to access these new audio files. In addition, the distribution application 1100 may also contain a video file module 1108, which includes a video file player 1111, as well as a video file converter 1110. Much as in the audio example above, video images (either still, or full motion) are converted from external sources to compressed standard formats and are placed in the repository 1116. Likewise, video files in the repository 1116 are displayed to the user by the video file player 1111" (Column 13, lines 6-24). The examiner further wishes to state that the converter of Fanning is used to convert large files stored on a "hard disk" (See "converting data stored on a CD-ROM or hard disk") of one peer into a compressed file for downloading. Applicant argues on page 04 that "The cited passages of Fanning equate the information item to a CD, and the smaller representation to an MP3 or similarly compressed audio file. However it is clear that the CD is not stored in the storage node (as the office Action notes, Fanning explicitly locates the full data at an external source - see Column 13, line 20), which is clearly contrary to "each storage node comprises a store configured to store a plurality of information items and an indexer". However, the examiner wishes to refer to Column 13 of Fanning which states "In an alternative embodiment shown in FIG. 9, the distribution application 1100 contains an audio file module 1102, which includes an audio file player 1106, as well as an audio file converter 1104. The audio file player 1106 plays files located in the data file repository 1116, while the audio file converter 1104 generates audio files either by sampling data from a microphone or tape, or by converting data stored on a CD-ROM or hard disk into a standard compressed audio file format. Converted audio files are placed in the repository 1116, allowing other users in the community to access these new audio files. In addition, the distribution application 1100 may also contain a video file module 1108, which includes a video file player 1111, as well as a video file converter 1110. Much as in the audio example above, video images (either still, or full motion) are converted from external sources to compressed standard formats and are placed in the repository 1116. Likewise, video files in the repository 1116 are displayed to the user by the video file player 1111" (Column 13, lines 6-24). The examiner further wishes to state that the converter of Fanning is used to convert large files stored on a "hard disk" (See "converting data stored on a CD-ROM or hard disk") of one peer into a compressed file for downloading. Thus, the original uncompressed information item is stored as is the compressed version available for downloading. Applicants argue on page 04 that "it is respectfully submitted that the storage node would not include the CD drive, ripper software etc, needed to generate the MP3, which would be required to maintain the assertion of equivalence with...still images mentioned in the same cited passage". However, applicants arguments are unfounded. Specifically, Fanning teaches that the original uncompressed file is stored on a hard disk (i.e., the hard drive of a peer, not an external drive) and converted for downloading by other peers via a repository. Applicant argues on page 04 that "it is respectfully submitted that Fanning does not describe the above two quoted features, and in fact Fanning actively teaches away from "each storage node comprises a store configured to store a plurality of information items and an indexer". However, Applicants are also reminded that in order to disqualify a reference based on a "teach away" reasoning, the reference has to explicitly suggest or disclose the so-called teach away steps - Applicants assertion can not be accepted if it is unsupported by a valid evidence. In this case, Fanning clearly teaches a store that stores an original uncompressed file (the hard disk) and a corresponding information that requires less storage capacity (the compressed version of the original file). Applicants argue on page 05 that "assuming arguendo that the compressed audio/video is considered to be the information item, Fanning clearly does not then disclose generating a smaller representation of it...network". However, the original uncompressed file stored on the hard disk teaches the original information item. The compressed file teach the claimed corresponding information item that requires less storage capacity. Applicants argue on page 05 that "The fact that either the full information item is not stored in the storage node in Fanning or that a smaller representation of the full information item is not generated in Fanning (one or the other of these interpretation must hold) means that a system based upon the teachings of Fanning cannot include the structural features of the claimed invention". However, once again, the original uncompressed file stored on the hard disk teaches the original information item. The compressed file teach the claimed corresponding information item that requires less storage capacity. Fanning clearly teaches the structure of the instant invention, contrary to applicant's unfounded viewpoints. Applicants argue on pages 05-06 that "the first user's server does not maintain any register of whether the file has already been sent to the second user. Indeed is also noted in Needham that the original first user may have deleted the file before the second user requests it (the request is broadcast to multiple servers, further undermining the interpretation that any one

server records whether the client has the file, as asserted the outstanding Office rejection". However, the examiner wishes to refer to Paragraph 19 of Needham which states "In the example of FIG. 1, Bob's index information packet for Bob's photograph has a DFC field of 0, Andy's index information packet for the photograph has a DFC field of 1 (reflecting the transfer of the index information from Bob to Andy), and Fred's index information packet for the same photograph has a DFC field of 3 (because that index came through June, Mary, and Bob)" (Paragraph 19). The examiner further wishes to state that the DFC field broadly teaches who has sent files in a chain. Thus, a client knows that a server already has sent a file to that client. Thus, a register at that client is maintained, and if that server requests files from that client (now acting as a server), that client knows via the DFC field, that the client has had the file. Applicants argue on page 06 that "we also respectfully assert that Needham does not disclose that the indexer in the storage node updates the register when data items are forwarded to the client". However, the examiner wishes to refer to Paragraph 19 of Needham which states "In the example of FIG. 1, Bob's index information packet for Bob's photograph has a DFC field of 0, Andy's index information packet for the photograph has a DFC field of 1 (reflecting the transfer of the index information from Bob to Andy), and Fred's index information packet for the same photograph has a DFC field of 3 (because that index came through June, Mary, and Bob)" (Paragraph 19). The examiner further wishes to state that the DFC field broadly teaches who has sent files in a chain. Thus, a client knows that a server already has sent a file to that client. Thus, a register at that client is maintained and updated, and if that server requests files from that client (now acting as a server), that client knows via the DFC field, that the client has had the file. Applicants argue on page 06 that "it is respectfully submitted that Needham does not in fact disclose a register in the server (storage node) and hence such a server cannot know what data has or has not been previously transmitted to a client, and hence cannot cause previously unsent data to now be sent". However, the examiner wishes to refer to Paragraph 19 of Needham which states "In the example of FIG. 1, Bob's index information packet for Bob's photograph has a DFC field of 0, Andy's index information packet for the photograph has a DFC field of 1 (reflecting the transfer of the index information from Bob to Andy), and Fred's index information packet for the same photograph has a DFC field of 3 (because that index came through June, Mary, and Bob)" (Paragraph 19). The examiner further wishes to state that the DFC field broadly teaches who has sent files in a chain. Thus, a client knows that a server already has sent a file to that client. Thus, a register at that client is maintained and updated, and if that server requests files from that client (now acting as a server), that client knows via the DFC field, that the client has had the file. Applicants argue on pages 06-07 that "it is respectfully submitted that there would be no suggestion or motivation to combine Needham with Fanning, as the combination of Needham with Fanning would make Fanning unsuitable for its intended purpose and would require a substantial redesign of Fanning. In this regard, the teachings of Needham are incompatible with those of Fanning with regards to the "data representing information items...would make Fanning unsuitable for its intended purpose and/or would require a substantial redesign of Fanning". However, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of a method to reduce bottlenecking when forwarding file requests in a distributed network clearly allows for Needham to be combined with Fanning. Moreover, such a combination would not make Fanning unsuitable/redesign it substantially. In contrast, only additional information would be stored alongside the compressed files of Fanning. Applicants argue on page 07 that "the proposed combination does not teach or suggest...Kohonen". However, the examiner directs applicant to pages 45-46 of the final office action mailed on 06/11/2009 to address this issue.